

REMARKS

In the last Office Action, the Examiner rejected claims 16 and 17, and allowed claims 5, 6, 10-15 and 22-26. Applicants appreciate the notice of allowable subject matter. Claims 5, 6, 10-17, and 22-26 remain pending in this application.

Rejections under 35 U.S.C. § 102(a)

Claim 16 - Gregory

Claim 16 was rejected under 35 U.S.C. § 102(a) as being anticipated by Gregory, U.S. Patent no. 6,305,848 ("Gregory"). Applicants respectfully traverse this rejection.

In order to properly anticipate Applicants' claimed invention under 35 U.S.C. §102, each and every element of the claim in issue must be found, "either expressly or inherently described, in a single prior art reference." "The identical invention must be shown in as complete detail as is contained in the . . . claim. *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989)." See M.P.E.P. § 2131, (8th ed., 2001).

Claim 16 recites a combination including, *inter alia*, "a housing removably mountable on a circuit board." Gregory, whether taken alone or in combination fails to teach at least this element. The Examiner, at page 2 of the Office Action, asserts that Gregory teaches a "housing" at Fig. 2, element 16, and that this "housing" is removably mountable on a circuit board 20. However, Applicants submit that, if anything, the circuit board 20 is mountable on the "housing" 16. This is shown in Fig. 2, a plurality of circuit boards 20 are mounted within a mounting block 16, the alleged "housing."

The Examiner has provided further support for this assertion in the Office Action at page 5 wherein the Examiner refers to Gregory and states that “the connectors **28** (which are part of boards **20** as seen in fig. 5) *are inserted in to the apertures 18 of the housing 16.*” (Emphasis added). Further support is found in Gregory at, for example, col. 6, lines 11-14. Therefore, Gregory fails to constitute a teaching of at least “a housing removably mountable on a circuit board.” Since Gregory fails to teach each and every element of the claim, such that “[t]he identical invention” is “shown in as complete detail as is contained in the ... claim,” Gregory cannot anticipate claim 16. Thus the rejection of claim 16 under 35 U.S.C. § 102(a) should be withdrawn and the claim allowed.

Rejections under 35 U.S.C. § 103(a)

Claim 17 – Gregory

The Examiner rejected claim 17 as being unpatentable under 35 U.S.C. § 103(a) as being obvious over Gregory. Applicants respectfully traverse this rejection.

To establish a *prima facie* case of obviousness under 35 U.S.C. §103(a), each of three requirements must be met. First, the reference or references, taken alone or combined, must teach or suggest each and every element recited in the claims. Second, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to combine the references in a manner resulting in the claimed invention. Third, a reasonable expectation of success must exist. Moreover, each of the three requirements must “be found in the prior art, and not be based on applicant’s disclosure.” See M.P.E.P. §2143, (8th ed., 2001).

Claim 17 recites a combination including at least, a “heat sink” which “includes heat fins.” Gregory fails to teach a combination including a “heat sink” with “heat fins.” The Examiner, at pages 2-3 of the Office Action, asserts that the “housing” or mounting block 16 has “heat dissipation features,” and that this constitutes a heat sink. Furthermore, the Examiner asserts that “[h]eat fins are old and well known,” and thus it would have been obvious to “provide housing with fins.”

When relying on common knowledge, or taking Official Notice, to support a rejection under 35 U.S.C. § 103(a), “the Board [or examiner] must point to some concrete evidence in the record in support of these findings” to satisfy the substantial evidence test. *In re Zurko*, 258 F.3d 1379, 1386, 59 USPQ2d 1693, 1697. Furthermore, if the examiner is relying on personal knowledge to support the finding of what is known in the art, the examiner must provide an affidavit or declaration setting forth specific factual statements and explanation to support the finding. See 37 CFR 1.104(d)(2). If the Examiner maintains the rejection by relying on the position that “heat fins” are old and well known in the art of optical transceivers, Applicants ask that the Examiner provide additional evidentiary evidence, either in the form of a reference or affidavit, to support this statement.

However, Applicants submit that it would be impractical to put fins onto the mounting block of Gregory, and therefore, there is no motivation for adding heat fins. As shown in Fig. 2, the mounting block 16 is designed to be fit into the mating optical connector 12. See *also* Gregory at, for example, col. 4, lines 49-61, and col. 5, lines 16-20. The addition of heat fins, to “increase the surface area” as asserted by the Examiner at page 3 of the Office Action, would make it difficult to fit the mounting block

16 into the mating connector 12. Therefore, there is no suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to combine the references in a manner resulting in the claimed invention, and a *prima facie* case for obviousness has not been made.

Moreover, claim 17 depends from claim 16, and therefore requires all of the elements of claim 16. As discussed above, Gregory fails to teach at least a “housing removably mountable on a circuit board.” Since Gregory, whether taken alone or in combination, fails to teach each and every element recited in the claims, a *prima facie* case of obviousness has not been made. Thus, the rejection of claim 17 under 35 U.S.C. § 103(a) should be withdrawn and the claims allowed.

Claims 16 and 17 – Robin

The Examiner rejected claims 16 and 17 under 35 U.S.C. § 103(a) as being unpatentable over Robin et al., U.S. Patent no. 5,134,679 (“Robin”). Applicants respectfully traverse this rejection.

Claim 16 recites “[a]n optical transceiver comprising.” Robin, whether taken alone or in combination fails to at least teach “[a]n optical transceiver.” Contrary to the Examiner’s assertion, Robin does not teach or suggest an optical transceiver. An optical transceiver, as its name implies, transmits and receives optical data from a fiber optic cable into an electrical signal, and translating electrical signals into optical data. See Applicant’s specification at, for example, page 1 lines 14-15.

Conversely, Robin is directed to a connector that is used to couple an optical fiber to a circuit board. Robin, col. 1, lines 44-50. Robin, at for example in Fig. 3, shows a housing 22 mounted on a circuit board 11, thereby coupling fiber optic cables

25 and 26 to the circuit board. However, Robin fails to teach or suggest the use of “[a]n optical transceiver,” as recited in claim 16.

“[A] claim preamble has the import that the claim as a whole suggests for it.” *Bell Communications Research, Inc. v. Vitalink Communications Corp.*, 55 F.3d 615, 620, 34 USPQ2d 1816, 1820 (Fed. Cir. 1995). “If the claim preamble, when read in the context of the entire claim, recites limitations of the claim, or, if the claim preamble is ‘necessary to give life, meaning, and vitality’ to the claim, then the claim preamble should be construed as if in the balance of the claim.” *Pitney Bowes, Inc. v. Hewlett-Packard Co.*, 182 F.3d 1298, 1305, 51 USPQ2d 1161, 1165-66 (Fed. Cir. 1999). *See also Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951). In *Kropa*, a preamble reciting “An abrasive article” was deemed essential to point out the invention defined by claims to an article comprising abrasive grains and a hardened binder and the process of making it. *Id.* at 481. The court stated “it is only by that phrase that it can be known that the subject matter defined by the claims is comprised as an abrasive article. Every union of substances capable *inter alia* of use as abrasive grains and a binder is not an ‘abrasive article.’” *Id.* Therefore, the preamble served to further define the structure of the article produced. *See also* M.P.E.P. § 2111.02 (8th ed., 2001).

Here, Claim 16, recites a combination including “a housing removably mountable on a circuit board” and “wherein the housing includes a heat sink.” Similar to *Kropa*, it is only by the preamble, “[a]n optical transceiver comprising,” that it can be known that the subject matter being claimed is comprised as an optical transceiver. Following the logic the court gave in *Kropa*, every structure that uses a combination including at least, “a housing removably mountable on a circuit board” and “wherein the housing includes a

heat sink,” is not “[a]n optical transceiver.” Thus the preamble, “[a]n optical transceiver comprising:” further defines the structure of the article being produced, and is a necessary element of the claimed invention. Therefore, since Robin, whether taken alone or in combination fails to teach or suggest every element of the recited claim, a *prima facie* case of obviousness cannot be made.

Moreover, claim 16 recites a combination including at least, “wherein the housing includes a heat sink,” and claim 17 further recites that the “heat sink” has “heat fins.” Robin, whether taken alone or in combination, fails to teach or suggest at least these elements. The Examiner asserts, at page 3 of the Office Action, that “heat sinks are old and well known in the art,” and that it “would have been obvious to provide said heat sink with heat fins.” As discussed above, Applicants would like further evidentiary support to show that the use of a “heat sink” with “heat fins” in the art of optical connectors, with which Robin is concerned, is, in fact, “old and well known.”

However, barring impermissible hindsight, there is no suggestion in Robin that the optical connector suffers from overheating problems that would provide a motivation to incorporate a “heat sink” with “heat fins” on the housing of Robin. Therefore, since there is not a suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to combine the references in a manner resulting in the claimed invention, a *prima facie* case of obviousness has not been made. Thus the rejection of claim 16, and claim 17 which requires all of the limitations of claim 16, under 35 U.S.C. § 103(a) should be withdrawn and the claims allowed.

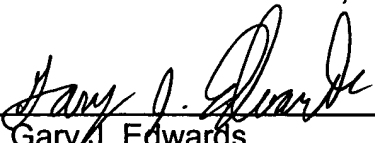
In view of the foregoing, Applicants respectfully request the reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

By: _____


Gary J. Edwards

Reg. No. 41,008

Dated: October 22, 2004